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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,503	07/11/2003	Joachim E. Klee	KON-76B	3984

7590 10/17/2006
Douglas J. Hura, Esquire
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570 West College Avenue
York, PA 17405

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,503

Applicant(s)

KLEE ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/31/06 Response.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The Applicants' amendment filed on July 31, 2006 is acknowledged.

Claims 5 and 7 are amended. Now, Claims 1-17 are pending.

2. Specification objection(s) in the previous Office Action (Paper No. 090305) is/are removed.

3. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Specification

4. The disclosure is objected to because of the following informalities:

In the last two lines of page 14, the statement "Q is an ether, an ester, an urethane or thiourethane linking group" causes confusion because when Q is an ether, formulae IV, V or VI are attached to the backbone of the hybrid monomer compound via a peroxy linkage. Applicants argue that the ether is an R-O-R linkage. However, it is not clear as to what moiety R in R-O-R corresponds to the formula in formulae IV, V and VI.

Claim Objection

5. Claim objection of Claim 5 is maintained because the rejection is adequately set forth in paragraph 2 of Paper No. 090305. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

In Claim 5 (page 7, line 7 from bottom), should "alkenyl" be -- alkenylene -- ?

6. Claims 4-6 are objected to because of the following informalities:

In Claims 4-6, the formulae are not legible.

Claim Rejections - 35 USC § 112

7. Rejection of Claims 4-5, 8-9 and 15-17 under 35 USC 112 is maintained because the rejection is adequately set forth in paragraph 4 of Paper No. 090305. Since the rejections appear not being addressed (Except the issue with Q in Claim 5). The rejections are repeated below.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered

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indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, Claim 4 recites the broad recitation "A is a polymerizable moiety" (line 7), and the claim also recites "preferably an acrylate or methacrylate group" (lines 7-8) which is the narrower statement of the range/limitation. The same issues occur in Claim 5 (page 7, lines 5 and 10 from bottom and page 8, line 1).

In Claim 4 (line 12), "X is a nitrogen atom" causes confusion because when A is an acrylate or methacrylate group, $(A)_n-X$ will be a group of $(H_2=C(H \text{ or } CH_3)-C(O)O)_n-N$.

In Claim 5, "R₃" is not defined in formulae 2, 6 and 8-10.

In Claim 5 (2nd line from bottom), the statement “Q is an ether, an ester, an urethane or thiourethane linking group” causes confusion because when Q is an ether, formulae IV, V or VI are attached to the backbone of the hybrid monomer compound via a peroxy linkage. Applicants’ argument is not persuasive because of the reason described in paragraph 4 above.

Regarding Claims 8, 9 and 15-16, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

In Claim 8 (lines 2-3 and 4-5), the Markush languages are improper.

In Claim 17, the word “obtainable” is not a positive limitation, and does not constitute a limitation in any patentable sense. See *In re Hutchinson*, 33 CCPA 879, 154 F. 2d 135, 69 USPQ 138 (CCPA 1946). Applicants are advised to replace “obtainable” by -- obtained --.

In Claim 17 (line 2), it is not clear as to what “any one of claim 1” refers to.

Claim Rejections - 35 USC § 102 and 103

8. The rejections as set forth in paragraphs 6 and 8-9 of Paper No. 090305 are deemed proper and are incorporated herein by reference. Since Applicants failed to respond to these grounds of rejection, no further response is required.

9. It is noted that the certified copy of the foreign priority paper, DE 10101537.2, is missing.


10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
October 3, 2006


Kuo-Liang Peng
Primary Examiner
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